

REMARKS

Applicant respectfully requests reconsideration of this application, as amended.

Applicant thanks the Examiner for the courtesies extended to Applicant's representative during the Interview conducted on July 12, 2006.

Applicant notes with appreciation the indication of allowable subject matter in Claims 10, 22, 23 and 33–38.

The Specification has been amended to correct a typographic error. Specifically, "titan" has been amended to "titanium" in the seventh full paragraph on Page 7. No new matter has been added.

Claims 1–38 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of co-pending Application No. 10/406,572 (the '572 application). Applicant notes that a request to expressly abandon the '572 application was filed on July 13, 2006, and a copy of that paper is attached hereto. Applicant submits that the provisional, obviousness-type double patenting rejection has been overcome.

Claims 1–9 and 11–21 were rejected under 35 U.S.C. § 102(b) as being anticipated by Toth et al. (US 6,491,670), while Claims 1–9, 11–21 and 24–32 were rejected as being anticipated by Manna (US 5,527,273). Claims 2, 12 and 27 have been canceled without prejudice and Claims 39–41 have been added. Without acceding to the rejections under § 102, Claims 1, 11 and 24 have been amended to more clearly recite certain features of the claimed invention. Claims 9 and 21 have been amended to depend from Claims 1 and 11, respectively, while Claims 39–41 have been added. Support for these amendments may be found, for example, in the Specification at Page 7 ("Usually, it is made of titan[ium]"), Pages 8–9 ("These openings 63 have like the single opening of the other embodiments blunt or rounded edges 61. In order to communicate with these openings 63, the lumen 4 is divided into sublumens 4', each sublumen 4' ending in one of the mentioned openings 63.") and in FIGS. 4, 10, 14, 18 and 19. No new matter has been added. Thus, Claims 1, 3–11, 13–26 and 28–41 are pending.

Claims 1, 11 and 24 are directed to a phacoemulsification needle for removing a cataract from an eye, and recite, *inter alia*, a shaft, a metal tip having an opening, and an aspiration

lumen, extending through the shaft and the tip, where the tip includes rounded edges disposed around the opening and extending to the aspiration lumen. Applicant respectfully submits that none of the cited references, taken either singly or in combination, teaches or suggests these features.

Toth discloses a surgical instrument having a soft, flexible tip. *See, e.g.,* Abstract ("Most preferably, the tip is formed of a compliant, yet self-supporting, material, such as medical grade transparent elastomer") and Claim 1 ("self-supporting solid bulbous elastomeric tip") (Col. 6:17). Toth fails to teach or suggest a metal tip, as recited by Claims 1, 11 and 24. Furthermore, Toth's elastomeric tip is completely unsuitable for transmitting ultrasonic energy, and, therefore, for use in phacoemulsification. Consequently, Toth fails to teach or suggest all of the features recited by Claims 1 and 11.

Manna discloses several liposuction probe tips having at least one opening in the tip, such as inlet bores or orifices 38, 40, 56, 58, 68, 80, 92 and 94. *See, e.g.,* Col. 10:54–55, 62–63; Col. 11:21–22; FIGS. 1, 2A, 3A, 4A, 5A and 6–11. Manna fails to teach or suggest a tip that includes rounded edges disposed around the opening in the tip and extending to the aspiration lumen. Instead, Manna's inlet bores are sharp, as depicted within FIGS. 1, 2A, 3A, 4A, 5A and 6–11. Consequently, Manna fails to teach or suggest all of the features recited by Claims 1, 11 and 24.

Moreover, Applicant submits that none of the cited references, taken either singly or in combination, teaches or suggests all of the features recited by Claims 1, 11 and 24.

Accordingly, Claims 1, 11 and 24 are allowable. Claims 3–9, depending from Claim 1, Claims 13–21, depending from Claim 11, Claims 25, 26 and 28–32, depending from Claim 24, respectively, are also allowable, at least for the reasons discussed above.

In view of the amendments and remarks presented herein, Applicant respectfully submits that this application is in condition for allowance and should now be passed to issue.

A Notice of Allowance is respectfully solicited.

If any extension of time is required in connection with the filing of this paper and has not been requested separately, such extension is hereby requested.

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Att'y Dkt: 1278-160

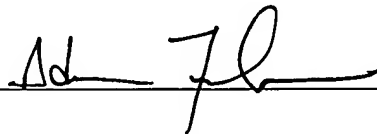
Reply Under 37 C.F.R. § 1.116
Expedited Procedure - Technology Center 3763

The Commissioner is hereby authorized to charge any fees and to credit any overpayments that may be required by this paper under 37 C.F.R. §§ 1.16 and 1.17 to Deposit Account No. 02-2135.

Respectfully submitted,

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